

## REMARKS

Applicants submit this Request for Continued Examination (RCE) and Amendment in response to the Board of Patent Appeals and Interferences Decision dated July 14, 2008, on Appeal No. 2008-0739, where the rejections of Claims 22-25, 27, 29-33, 35 and 37-40 for obviousness under 35 U.S.C. § 103(a) were affirmed. Claims 22-25, 27, 29-33, 35 and 37-40 are pending and stand rejected and Claims 26, 28, 34 and 36 were objected to. Claims 22, 26, 28, 30, 34, 36, 38, and 40 has been amended. Applicants respectfully request reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. § 103**

Claims 22-24, 29-32 and 37-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over International Application Publication No. WO 99/45687 by Jay R. Yablon (“*Yablon*”) in view of “Control Protocol for Multimedia Communication,” by the International Telecommunication Union (“*ITU*”).

Claims 25, 27 33 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yablon* in view of *ITU* and further in view of U.S. Patent No. 5,592,546 issued to Kouichi Takahashi (“*Takahashi*”)

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the

known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicant amended the independent claims 22, 30, 38, and 40 to include the limitation that the first or further telecommunication device can be configured with respect to which type of data it allows to be transmitted. This limitation is disclosed in the originally submitted specification, for example on page 5, line 3 to 6. Thus, no new matter has been introduced. *Yablon* does not disclose this feature. According to *Yablon* a handshake process is started when two telecommunication devices are setting up a call in which the capabilities of one device are transmitted to the other device. However, this system does not allow a user to configure his device to only receive certain types of data despite the fact that the device has a broader capability. *Yablon* is particularly silent with respect to any configurability of the telecommunication device let alone of adapting the device information according to the configured functionality.

Hence, Applicant believes that all independent claims are now allowable in view of the cited prior art. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

**Allowable Subject Matter**

Applicants appreciate Examiner's consideration and indication that Claims 26, 28, 34 and 36 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants amended claims 26, 28, 34, and 36 to be in independent form including all the limitations of the respective intervening claims.

**Request for Continued Examination (RCE)**

Applicants authorize the Commissioner to charge \$810.00 for the Request for Continued Examination (RCE) Transmittal fee to Deposit Account No. 50-2148 of Baker Botts L.L.P.

**Association of Customer Number and Change of Correspondence Address**

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to Andreas H. Grubert at (512) 322-2545. A Revocation and Power of Attorney is submitted herewith.

### CONCLUSION

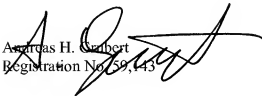
Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants authorize the Commissioner to charge \$810.00 for the Request for Continued Examination (RCE) Transmittal fee to Deposit Account No. 50-2148 of Baker Botts L.L.P. Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at (512) 322-2545.

Respectfully submitted,  
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Date: September 11, 2008

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